

AF/1/2735

Atty. Docket No. STE01 P-798B

CERTIFICATE OF MAILING

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Rebecca A. Westers
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Technology Center 2600

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Art Unit : 2735
Examiner : B. Zimmerman
Appellants : Joel D. Stanfield et al.
Appln. No. : 08/998,302
Filed : December 24, 1997
For : ELECTRONIC SYSTEM, COMPONENTS AND METHOD FOR TRACKING FILES

Assistant Commissioner for Patents
Washington D.C. 20231

TRANSMITTAL OF APPEAL BRIEF
(PATENT APPLICATION - 37 CFR §1.192)

1. Transmitted herewith, in triplicate, is the APPELLANT'S BRIEF in this application, with respect to the Notice of Appeal filed on September 22, 2000.

2. **STATUS OF APPLICANTS**

This application is on behalf of:

X other than a small entity.

___ a small entity.

A verified statement:

___ is attached.

___ was already filed.

3. **FEE FOR FILING APPEAL BRIEF**

Pursuant to 37 CFR §1.17(c), the fee for filing the Appeal Brief is:

___ small entity \$155.00

X other than a small entity \$310.00

Appeal Brief fee due: \$310.00

Applicant : Joel D. Stanfield et al.
Appln. No. : 08/998,302
Page : 2

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4. **EXTENSION OF TERM**

The proceedings herein are for a patent application and the provisions of 37 CFR §1.136 apply.

X Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

5. **TOTAL FEE DUE**

The total fee due is:

Appeal Brief fee: \$310.00

Extension fee (if any) \$000.00

TOTAL FEE DUE: \$310.00

6. **FEE PAYMENT**

X Attached is a check in the sum of \$310.00.

— Charge Account No. 16 2463 the sum of \$_____.

A duplicate of this transmittal is attached.

7. **FEE DEFICIENCY**

X If any additional extension and/or fee is required, this is a request therefor and to charge Account No. 16 2463.

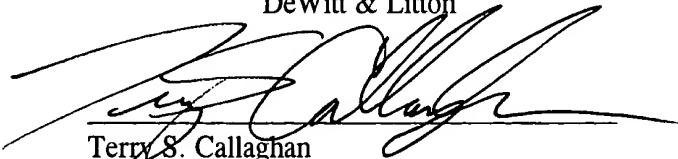
Respectfully submitted,

JOEL D. STANFIELD ET AL.

By: Price, Heneveld, Cooper,
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APPELLANTS' BRIEF (37 CFR §1.192)

This brief is in furtherance of the Notice of Appeal filed in this case on September 22, 2000.

The fees required under §1.17(f), and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief is transmitted in triplicate. (37 CFR §1.192(a)).

This brief contains these items under the following headings, and in the order set forth below (37 CFR §1.192(c)):

- I. Real Party in Interest
- II. Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments

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Appellant : Joel D. Stanfield et al.
Appln. No. : 08/998,302
Page : 2

V. Summary of Invention

VI. Issues

VII. Grouping of Claims

VIII. Arguments

A. The References

1. U.S. Patent No. 5,455,409 issued to Smith et al.
2. U.S. Patent No. 4,376,936 issued to Kott
3. U.S. Patent No. 5,424,858 issued to Gillotte

B. Legal Considerations

IX. Conclusion

Appendix of Claims Involved in the Appeal

The final page of this brief bears the attorney's signature.

I. Real Party in Interest

The real party in interest in this application is Steelcase Development Inc., the assignment to which was recorded at Reel 010161, Frame 0874 on August 10, 1999. Steelcase Development Inc. is a wholly owned subsidiary of Steelcase Inc.

II. Related Appeals and Interferences

Appellants are aware of no appeals or interferences that would directly affect or be directly affected by, or have a bearing on, the Board's decision in the pending appeal.

III. Status of Claims

This is an appeal from a final rejection of claims 1, 11-13, and 38-41 of the above-identified application. Claims 1-63 were originally presented. Claims 2-10, 14-37, and 42-63 have been withdrawn from consideration as a result of a restriction requirement. Appellants have filed a petition requesting withdrawal of the restriction requirement. No claims currently stand allowed. Appealed claims 1, 11-13, and 38-41, as last amended, are attached in the Appendix hereto.

Appellant : Joel D. Stanfield et al.
Appln. No. : 08/998,302
Page : 3

IV. Status of Amendments

All Amendments filed in this application have been entered.

V. Summary of the Invention

The present invention relates to an electronic system for tracking/locating file folders in an office environment. The system of the present invention would, for example, automatically track and locate patent application file folders in the U.S. Patent and Trademark Office without requiring any employee to take any positive manual action such as scanning a barcode each time a file is relocated. Provided employees place the file folders in a file cabinet, shelves, or on a particular stack on the employee's desk, the inventive system will automatically determine and update the location of the file folder thereby allowing another employee to readily locate the file folder at their own or a designated workstation. Not only can the inventive system identify, for example, a particular room or department in which the file is located, but the system may also identify the particular location of the file in the room or department.

An advantage the present system offers over all prior systems is that it may be used to track files that are contained in various types of folder retainers, such as file cabinets, file trays, shelving units, desk tops, and/or desk pads on or in which file folders are typically located in an office environment.

According to one aspect of the invention, as set out in independent claim 1, described in page 8, line 20 through page 9, line 18 and page 12, lines 5-17 of the specification and shown in Figs. 1 and 3, the invention is directed to a file tracking system (10) comprising: a database (shown and described as being embodied in processor/PC 20) for maintaining file location and unique file addresses for a plurality of files; a processor (20) for interfacing with the database and issuing control signals; a bus (30) connected to the processor; a folder retainer (40, 50, 60, 85) connected to the processor by the bus; and a plurality of file folders (70) each including an addressable device (76, 76a, 76b, Fig. 3) adapted to be electrically connected to the bus when the file folder is placed in the folder retainer. Each addressable device is responsive to a control signal including the unique address associated with the

addressable device to transmit a signal back to the processor so that the processor may maintain the file location of each file in the database. As recited in claim 11 and shown in Figs. 5 and 6 and described on page 17, lines 4-7, each of the file folders includes a surface, a first conductor (73a, 73b) on the surface for providing control signals to the addressable device when the file folder is placed in the folder retainer, and a second conductor (72a, 72b) on the surface for providing a ground to the addressable device. As described on page 15, line 18 through page 16, line 11, the folder retainer may include at least one surface, a first conductive rail (83a-83c) positioned on the surface for providing power and control signals to the addressable devices positioned on the plurality of file folders when the file folders are placed in the folder retainer, and a second conductive rail (82a-82c) positioned on the surface for providing a ground to the addressable devices when the plurality of file folders are placed in the folder retainer (claim 12). At least one of the conductive rails may be integrated into a suspension rail of a file drawer (54) upon which hanging file folders may be suspended (see page 16, lines 11-16).

The features, advantages, and flexibility of the system of the present invention are made possible through various combinations of the system elements described in this application. For example, by providing a hierarchy of addressable devices, the file folders may be placed in a plurality of different folder retainers at different locations within the system and the system will automatically determine their location without requiring any additional activity on the part of the user. More specifically, the bus that interconnects all of the folder retainers in the system to the processor may be segmented with addressable devices having unique addresses associated with each segment of the bus. Additionally, addressable devices having their own unique address may be associated with each file cabinet, file drawer, bookcase, shelf, desk, and file folder. This hierarchy enables the processor to separately activate specific segments of the bus and specific folder retainers one at a time or in groups to determine the location of a file folder that responds to the transmittal of its unique address through the activated bus segments and folder retainer, by transmitting a reply signal back to the processor.

The ability of the system to perform this function results from the ability of the system to conduct two-way communication with each addressable device provided on each file folder.

A key part of this two-way communication is the fact that each addressable device on the file folders is responsive to a control signal that includes the unique address of that file folder. This allows the system to locate a file randomly placed within a folder retainer, such as a file cabinet, by the use of a common communication path to all the file folders within a folder retainer without requiring the use of any dedicated lines separately connected to each addressable device. The common communication path along with a power supply may be implemented using a two- or three-wire bus. If it were necessary to run dedicated lines to each file folder, the system would not be practical in any office having any appreciable number of file folders to track.

The above features are further enhanced by the periodic polling by the processor of each file folder within the system and by the subsequent comparison of received information to the information contained within the database. Thus, by polling the file folders and comparing the information received with the information in the database, the processor may determine when a file has been removed and make the appropriate notation and time stamp in the database so that the activity log and historical information for that file will show when the file was removed or added back into the system at another location. As explained in the specification, this polling is affected by the processor separately activating different segments of the bus and transmitting the unique address of each file folder previously associated with that segment to see if a response is received. The specifics of how these features and elements are recited in the claims and the advantages they offer over the prior art are discussed below in the context of the specific claims.

According to another aspect of the invention, as set out in independent claim 38 and described on page 17, line 18 through page 20, line 15, the invention is directed to an electronic file tracking system (10) comprising: a processor (20) for issuing control signals; a folder retainer (40, 50, 60, 85) having electrical contacts (80) communicatively coupled to the processor; and a plurality of file folders (70), each including an addressable device (76) for electrically coupling to the processor when the file folder is placed in the folder retainer, and a conductor (72, 73, Figs. 5 and 6) located on the file folder and configured so as to electrically couple the addressable device to the electrical contacts of the folder retainer when the file folder is positioned in any one of several different positions. For at least one file folder, the

Appellant : Joel D. Stanfield et al.
Appln. No. : 08/998,302
Page : 6

conductor is configured to electrically couple the addressable device to the electrical contacts of the folder retainer at a plurality of locations on the file folder. The “plurality of locations” may include the side surface of the file folder (see claim 39), the edge surface of the file folder (see claim 40), or both (claim 41).

The inventive file tracking system provides additional flexibility in that it allows the location of file folders regardless of their orientation within or on a folder retainer. For example, files that are stacked vertically may be rotated in a different orientation from one another while still providing an electrical communication path between the addressable device on the upper most file folder and the conductors provided in the file tray in which the files are stacked. Further, the hanging files may be non-handed such that they may be hung in a file cabinet drawer in a position rotated 180° without interrupting the ability of the system to communicate with the addressable device on that file folder. Thus, the present invention provides great flexibility in the manner that employees may use the system and store file folders. As explained further below, the configuration of the electrical conductor on the file folder to enable electrical coupling of the addressable device to the electrical contacts of the folder retainer at a plurality of locations on the file folder, is a major reason the system can provide the flexibility described above.

VI. Issues

The issue on appeal is whether claims 1, 11-13, and 38-41 are patentable under 35 U.S.C. §103 over the combination of U.S. Patent No. 5,455,409 issued to Smith et al. and either U.S. Patent No. 5,424,858 issued to Gillotte or U.S. Patent No. 4,376,936 issued to Kott.

VII. Grouping of Claims

Claims 1 and 11-13 stand or fall together, and claims 38-41 stand or fall together. The two groups of claims stand or fall separately from one another for the reasons stated in detail below.

Appellant : Joel D. Stanfield et al.
Appln. No. : 08/998,302
Page : 7

VIII. Arguments

Claims 1 and 11-13 do not stand or fall with claims 38-41 and are considered separately patentable because independent claim 1 recites features not recited in independent claim 38, and because independent claim 38 recites some features not recited in independent claim 1. Specifically, independent claim 1 recites “a database,” “a bus,” and that each addressable device on the file folders is “responsive to a control signal including the unique address associated with the addressable device to transmit a signal back to said processor so that said processor may maintain the file location of each file in said database,” whereas independent claim 38 does not specifically recite any of those features. Further, independent claim 38 recites that each file folder includes “a conductor located on the file folder and configured so as to electrically couple said addressable device to the electrical contacts of said folder retainer when said file folder is positioned in any one of several different positions, wherein, for at least one file folder, said conductor is configured to electrically couple said addressable device to the electrical contacts of said folder retainer at a plurality of locations on said file folder,” whereas claim 1 does not require that any conductors on the file folders be so configured. For these reasons, Appellant contemplates that claims 1 and 11-13 may be held separately patentable relative to claims 38-41.

In the arguments below, brief descriptions are provided for both of the applied references followed by Appellants’ arguments as to why *prima facie* obviousness has not been established based upon the three cited references.

A. References

Although it is recognized that one cannot show non-obviousness by attacking references individually where the rejection is based on a combination of references, *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981) and *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986), the teachings in the individual references must nevertheless be considered when analyzing whether one of ordinary skill in the art would have considered combining such teachings and whether the hypothetical structure that would have resulted from the combined teachings would have included all the claimed features. For these reasons, the individual references applied in the rejections are first discussed separately below to allow for a complete understanding of what these references would have suggested to one of ordinary

skill in the art and to establish a basis for Appellants' position that one of ordinary skill in the art would not have considered combining the reference teachings in the manner contemplated by the Examiner.

1. U.S. Patent No. 5,455,409 Issued to Smith et al.

Smith et al. discloses an apparatus and method for monitoring the location of a plurality of computer tapes and for identifying the current location of a selected tape. More particularly, the apparatus includes at least one tape carrier (12a-12o, Fig. 6) each having a plurality of slots (30, Fig. 2) for receiving a tape cartridge (10, Fig. 1). Each slot includes a contact pad 38 (Fig. 3A) including a plurality of electrical contacts for contacting corresponding contacts 22 (Figs. 1 and 3B) provided on the tape cartridge 10. Each tape cartridge includes a memory device for storing a unique volume/serial number identifying that tape cartridge. As shown in Fig. 13, the contact pad (38a-38c) associated with each slot includes four contact terminals (40a-40d) - two for receiving power, one for providing an enable signal to the memory device on the tape cartridge positioned within the slot, and one for receiving the unique volume/serial number from the memory device on the tape cartridge provided therefrom when an enable signal is sent to the contact pad associated with the slot in which the tape cartridge is located.

Referring to Fig. 6, each of the tape carriers 12 includes a control circuit 42 having a microcontroller 300 (Fig. 13) that is coupled to a host computer 52. When a particular tape cartridge is to be located using this apparatus, the volume/serial number of the tape is input into host computer 52 and subsequently transmitted from the host computer to each of the control circuits 42 associated with the tape carriers 12. The microcontrollers 300 within the control circuits 42 respond to the tape request signal including the volume/serial number by polling the memories of each tape cartridge stored in one of its slots to determine whether a tape having the requested volume/serial number is present in the associated tape carrier 12.

To poll each of the tape cartridges, microcontroller 300 transmits an enable signal over a dedicated line 45b, 332, or 334 (Fig. 13) associated with a particular slot of the tape carrier. If there is a tape cartridge in that slot, the memory device of the tape cartridge responds to the enable signal by allowing its volume/serial number to be read by microcontroller 300 over line

45a, which is commonly connected to all of the slot contact pads. By knowing to which slot it last sent an enable signal, microcontroller 300 knows to which slot a received volume/serial number corresponds. Microcontroller 300 thereby stores the received volume/serial number in its memory at an address location dedicated to the particular slot from which the volume/serial number was received. Microcontroller 300 then sequentially and separately enables the memory devices of each tape cartridge stored in one of its slots and stores the volume/serial number sent by those tape cartridges in memory address locations associated with each respective slot.

Once polling is completed, microcontroller 300 compares the requested volume/serial number received from host computer 52 to the volume/serial numbers stored in its memory. If the requested volume/serial number is not found in its memory, microcontroller 300 does not respond to host computer 52. If microcontroller 300 determines that the requested volume/serial number corresponds to a volume/serial number stored in its memory, microcontroller 300 signals host computer 52 by identifying itself to host computer 52 and then illuminates a lamp positioned on the front of the tape carrier that is associated with the slot in which the requested tape is located. Meanwhile, host computer 52 displays the identification of the tape carrier whose microcontroller responded to the tape request.

2. U.S. Patent No. 4,376,936 Issued to Kott

The Kott patent discloses a docket card-locating device whereby each docket card folder includes a memory having a unique code stored therein, and an indicator light that is illuminated when a control signal is sent over a conductive rail upon which the docket card folders are hung that includes the code stored in the memory for that docket card folder. The Kott device, however, does not disclose that the devices on each docket card folder can, in any way, send reply signals back to the control circuit. Further, the Kott device does not maintain any form of database including the identification codes of the docket cards contained within the docket card box.

Appellant : Joel D. Stanfield et al.
Appln. No. : 08/998,302
Page : 10

3. U.S. Patent No. 5,424,858 Issued to Gillotte

The Gillotte patent discloses a system for locating file folders. It discloses a shelving unit having a pair of electrical conductors for providing power to the signal means 22 on each folder. The signal means 22 receives and transmits data to a remote computer via wireless signaling. The electrical conductors 24 and 26 are only provided for the supply of power to the signal means 22. No data is transmitted on these conductors. Additionally, the electrical conductors 24 and 26 are not coupled to a processor.

B. Legal Considerations

Appellants respectfully submit that a *prima facie* case of obviousness has not been established. The requirements for making a *prima facie* case of obviousness are described in MPEP §2143 as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success *must both be found in the prior art*, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). [Emphasis added]

Appellants submit that one of ordinary skill in the art would not have considered modifying the Smith et al. system to incorporate the features of Kott or Gillotte. Further, even assuming that one skilled in the art would have been motivated to make such a combination, the combined teachings of Smith et al., Kott, and Gillotte fail to teach or suggest each and every element recited in each of the claims.

MPEP §2143.01 provides further guidance as to what is necessary in showing that there was motivation known in the prior art to modify a reference teaching. Specifically, MPEP §2143.01 states:

Appellant : Joel D. Stanfield et al.
Appln. No. : 08/998,302
Page : 11

The mere fact that references can be combined or modified does not render the resultant combination obvious *unless the prior art also suggests the desirability of the combination*. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). [Emphasis added]

For the reasons stated below, Appellants submit that the requisite motivation for combining the teachings of the Smith et al., Kott, and Gillotte patents has not been established, and therefore, *prima facie* obviousness has not been established. More specifically, Appellants submit that neither Smith et al., Kott, nor Gillotte suggest the *desirability* of the modification that would be necessary to provide a system that even remotely resembles the claimed invention.

1. Claims 1 and 11-13

Independent claim 1 defines a file tracking system comprising a combination of elements including at least "a plurality of file folders, each file folder including an addressable device adapted to be electrically connected to said bus when the file folder is placed in said folder retainer, *each addressable device being responsive to a control signal including the unique address associated with the addressable device* to transmit a signal back to said processor so that said processor may maintain the file location of each file in said database."

As generally discussed above, this aspect of the present invention contributes to the system's ability to track the location of files particularly when a hierarchy of addressable switches is employed for each folder retainer and bus segment. Specifically, the processor may locate a requested file by activating the bus segments between the processor and the last known location of the requested file (including the segment of the bus in a particular folder retainer), transmitting a control signal including the unique identification code of the file on the activated segments of the bus, and awaiting receipt of a return signal from the requested file folder that indicates that the requested file folder is located in the folder retainer having its connecting bus segment activated at that time. If no return signal is received, the processor sequentially activates each segment of the system bus until a return signal is received, at which point the processor can identify the location of the file folder.

The Smith et al. system is designed to track tape cartridges or other articles when placed in separate slots. The system is constructed for use in computer tape cartridge libraries

Appellant : Joel D. Stanfield et al.
Appln. No. : 08/998,302
Page : 12

where robotic arms remove and place the tape cartridges in their respective slots. To track file folders, the system would require that a separate slot be provided for each file folder. Such an arrangement is clearly impractical in an office environment where file folders may be stacked on top of one another on a desk, hanging in a vertical file cabinet, or placed on the shelf of a book cabinet. Despite the fact that the background portion of the Smith et al. patent refers to the organization and management of "articles such as books, tapes, cassettes, and the like," one skilled in the art who was seeking to construct a practical system for tracking file folders in an office environment clearly would not have considered a system such as that disclosed in Smith et al.

As discussed above, Smith et al. system has dedicated lines run to each slot in a tape carrier such that a memory enable signal may be specifically directed to the contact pad in a slot where a tape cartridge may be positioned. The Smith et al. patent does not disclose or suggest the need to transmit a unique address of a particular tape cartridge to the tape itself over the dedicated line. Because the memory enable signal that is sent by the processor in Smith et al. to each tape cartridge is sent over a separate isolated dedicated line, there is absolutely no need to transmit the unique address (*i.e.*, volume/serial number) of the tape cartridge over that line to cause it to respond by transmitting its volume/serial number back to the processor. Further, because the processor does not access a database prior to sending a polling signal, it would not know which volume/serial numbers to transmit over each dedicated line, nor would it know how to obtain a response from a tape cartridge that was newly added into a tape carrier slot since it would not know its volume/serial number to begin with. Thus, Smith et al. does not teach or suggest that each addressable device on the tape cartridges be responsive to a control signal that includes the unique volume/serial number associated with that tape cartridge to transmit a signal back to the processor, as required by independent claim 1.

In the remarks portion of the Office Action mailed June 22, 2000, the Examiner characterized Appellants' prior arguments as follows:

- a. The applicant argues that the references do not show an addressable file folder responsive to a control signal including a unique address to transmit a signal back to the processor so that the processor may maintain the file location in a database.

Appellant : Joel D. Stanfield et al.
Appln. No. : 08/998,302
Page : 13

With respect to the above paragraph, the Examiner quotes the Abstract of Smith and contends:

It is clear from this section of Smith shows [sic] an addressable file folder responsive to a control signal including a unique address to transmit a signal back to the processor (footnote 2 above) so that the processor may maintain the file location in a database (footnote 1 above).

Appellants submit that the Abstract of Smith et al. does not support the above-quoted conclusions. Nowhere does the Abstract of Smith et al. state that the control signal to which the addressable file folders would be responsive would include a unique address of the file folder. While the Abstract of Smith et al. does disclose that the system polls and searches the system to identify the carrier in which a requested article is stored, the manner by which the Smith et al. system polls and searches the system to identify the location of such a cartridge is much different than that utilized in the claimed invention. Specifically, the Smith et al. system merely transmits a memory read enable signal separately to each of the tape cartridges over a dedicated line coupled to an associated slot such that the tape cartridge in the slot will respond by transmitting its unique volume/serial number back to the polling controller. Thus, the control signal clearly does not include a unique address corresponding to the tape carrier nor would there be any reason to modify the Smith et al. system such that a unique address is transmitted to each tape cartridge.

As discussed further below, neither Gillotte nor Kott teaches or suggests an addressable file folder responsive to a control signal including a unique address, to transmit a signal back to the processor. Thus, neither Gillotte nor Kott teaches or suggests the deficiency noted above with respect to Smith et al. Further, because Smith et al. utilizes a dedicated line connected between the processor and each separate tape cartridge slot, there would be absolutely no reason why the processor would need to transmit a control signal that included a unique address for a tape cartridge. While the host processor of Smith et al. may transmit the volume/serial number of a requested tape cartridge, the volume/serial number transmitted from the host processor is never received by the tape cartridge itself. Thus, one skilled in the art

Appellant : Joel D. Stanfield et al.
Appln. No. : 08/998,302
Page : 14

would not have found it to be desirable to modify the Smith et al. system based on the teachings of Kott or Gillotte.

As noted above, Kott discloses a device for locating docket cards in a box whereby a controller transmits a signal including a unique ID code of a selected docket card simultaneously to all the docket cards in the box. An indicator on the docket card having the unique ID code then illuminates. The indicator devices in the Kott device do not transmit any signals back to the controller.

Although it is not very clear how exactly the Examiner believes that one of ordinary skill in the art would have constructed a system based upon the combined teachings of Smith et al. and Kott, it is apparent that there are certain features of Kott that one of ordinary skill in the art would not have considered implementing in the Smith et al. system since it would destroy some important functions that are performed by the Smith et al. system. For example, because the Smith et al. system utilizes a dedicated and separate line for each tape slot and indicator light, the Smith et al. system does not transmit the identification code of the tape to the tape itself or to the indicator light at any time. Although the Kott patent does require that the code for the file be transmitted to the indicator device mounted on the docket card folder, the fact that the Kott docket card box does not allow for the docket card folders to transmit their identification codes back to a processing circuit would destroy the ability of the Smith et al. system to determine the location of a particular item in a plurality of such retainers if the particular implementation in Kott were somehow used in the Smith et al. system.

It is not at all clear how or why one skilled in the art would modify the Smith et al. system based on the teachings of Gillotte. As noted above, Gillotte discloses the wireless transmittal of locating signals between the controller and a file case. If Smith et al. were modified based on the teachings of Gillotte, it would not recite all the features recited in the pending claims. Specifically, the processor would no longer be coupled to the folder retainer by a bus, as recited in claim 1.

As stated above, there would have been no reason why one skilled in the art would have considered modifying the Smith et al. system based on either Kott or Gillotte, and even if such motivation existed, the resultant system would not include all the features of claim 1.

Appellant : Joel D. Stanfield et al.
Appln. No. : 08/998,302
Page : 15

Thus, claims 1 and 11-13 are allowable over Smith, Kott, and Gillotte whether considered separately or in combination.

2. Claims 38-41

Independent claim 38 is directed to an electric file tracking system that includes the features presented in original independent claim 1 except for a bus and a database, and further recites that each file folder includes a conductor located on the file folder and is configured so as to electrically couple the addressable device on each file folder to the electrical contacts of the folder retainer when the folder retainer is positioned in any one of several different positions, wherein the conductor (which couples the addressable device to the processor) is configured to electrically couple the addressable device to the electrical contacts of the folder retainer *at a plurality of locations on the file folder*. None of the cited references teaches or suggests this feature. Specifically, in Smith et al., the tape cartridges do not include conductors that are configured to couple the memory device to the contacts in the tape carrier when the tape cartridge is positioned in one of several different positions. Clearly, the slots and tape cartridges are dimensioned such that the tape cartridges may not be positioned in the tape carrier in more than one position such that electrical contact could still be made. Further, the contacts of the tape cartridge are not located at a plurality of locations on the tape cartridge.

The Kott reference does not disclose that the electrical contacts on the docket card folders would continue to make contact if the position of the docket card folder were in any different position than that disclosed in the patent, nor that the electrical contacts are positioned a plurality of locations on the docket card. The Gillotte patent does not disclose that such electrical conductors electrically couple the addressable device to the electrical contacts of the folder retainer, which, in turn, are coupled to the processor, nor does Gillotte disclose providing contacts on a plurality of locations on a file folder.

In the remarks portion of the Office Action mailed June 22, 2000, the Examiner characterized Appellants' prior arguments as follows:

Appellant : Joel D. Stanfield et al.
Appln. No. : 08/998,302
Page : 16

b. The applicant argues that the references do not show a [sic] retainer contacting the bus when the retainer is in any one of several different positions.

Regarding the above paragraph, the Examiner explains:

Regarding claim 38, the claims previously required coupling when the retainer is positioned in one of several different positions. As it has been previously discussed, the references to Kott and Gillotte both show this since the retainers of the references at least are coupled in one position.

In the claims however, in order to overcome the above interpretation, the applicant has amended to require coupling when the retainer is positioned [sic] any one of several positions. First it is believed that this language does not overcome the above interpretation, in that the references each show coupling in one orientation. Secondly, the references read on the claim language since there is coupling whether the retainer is the first retainer in the cabinet and also if the retainer is positioned in the back of the row. Therefore, there is coupling in any one of several positions.

Appellants submit that the Examiner has apparently misunderstood Appellants' prior arguments as well as the claims. Specifically, claim 38 recites "for at least one file folder, said conductor is configured to electrically couple said addressable device to the electrical contacts of said folder retainer at a plurality of locations *on said file folder*." Regardless of whether a file folder in Kott is placed at the front or back of the file cabinet, the conductor on the file folder is not configured to electrically couple the addressable device carried on the file folder to the electrical contacts of the folder retainer "at a plurality of locations on said file folder," as recited in claim 38. Instead, the conductors on the Kott file folder contact the electrical contacts of the retainer at only one location *on the file folder* despite the fact that the folder contacts the retainer contacts at several locations *along the container contacts*. Neither Smith nor Gillotte teaches or suggests this deficiency with respect to the teachings of Kott. Accordingly, none of the references, whether considered separately or in combination, teaches or suggests the features recited in independent claim 38. Thus, independent claim 38 as well as claims 39-41, which depend therefrom, are allowable over the teachings of Smith and either Kott or Gillotte.

Appellant : Joel D. Stanfield et al.
Appln. No. : 08/998,302
Page : 17

As stated above, there would have been no reason why one skilled in the art would have considered modifying the Smith et al. system based on either Kott or Gillotte, and even if such motivation existed, the resultant system would not include all the features of claim 1. Thus, claims 38-41 are allowable over Smith, Kott, and Gillotte whether considered separately or in combination.

IX. Conclusion

For the reasons set forth above, and as is apparent from examining the invention defined by claims 1, 11-13, and 38-41 when properly considering the cited references, these claims define patentable subject matter. Accordingly, reversal of the rejection of these claims under 35 U.S.C. §103 is appropriate and is respectfully solicited.

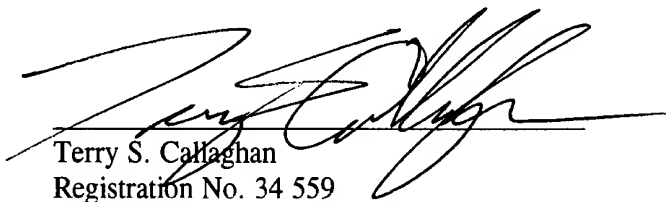
Respectfully submitted,

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Appendix of Claims

1. A file tracking system comprising:
 - a database for maintaining file location and unique file addresses for a plurality of files;
 - a processor for interfacing with said database and issuing control signals;
 - a bus connected to said processor;
 - a folder retainer connected to said processor by said bus; and
 - a plurality of file folders, each file folder including an addressable device adapted to be electrically connected to said bus when the file folder is placed in said folder retainer, each addressable device being responsive to a control signal including the unique address associated with the addressable device to transmit a signal back to said processor so that said processor may maintain the file location of each file in said database.
11. The file tracking system of claim 1, wherein each of said file folders further include:
 - a surface;
 - a first conductor on said surface for providing control signals to said addressable device when the file folder is placed in said folder retainer; and
 - a second conductor on said surface for providing a ground to said addressable device.
12. The file tracking system of claim 1, wherein said folder retainer includes:
 - at least one surface;

a first conductive rail positioned on said surface for providing power and control signals to the addressable devices positioned on said plurality of file folders when said file folders are placed in said folder retainer; and

a second conductive rail positioned on said surface for providing a ground to the addressable devices when said plurality of file folders are placed in said folder retainer.

13. The file tracking system of claim 12, wherein at least one of said first and second conductive rails are integrated into a suspension rail of a file drawer upon which hanging file folders may be suspended.

38. (Twice Amended) An electronic file tracking system comprising:

a processor for issuing control signals;

a folder retainer having electrical contacts communicatively coupled to said processor;

and

a plurality of file folders, each file folder including an addressable device for electrically coupling to said processor when the file folder is placed in said folder retainer, and a conductor located on said file folder and configured so as to electrically couple said addressable device to the electrical contacts of said folder retainer when said file folder is positioned in any one of several different positions, wherein, for at least one file folder, said conductor is configured to electrically couple said addressable device to the electrical contacts of said folder retainer at a plurality of locations on said file folder.

39. The electronic file tracking system of claim 38, wherein at least one of said plurality of locations is the side surface of said file folder.

40. The electronic file tracking system of claim 38, wherein at least one of said plurality of locations is the edge surface of said file folder.

41. The electronic file tracking system of claim 38, wherein one of said plurality of locations is the side surface and another one of said plurality of locations is the edge surface of said file folder.